

## REMARKS

Claims 32 and 34-58 are pending in this application and are presented for reconsideration

Applicants have corrected a self-evident error on page 24, paragraph 2 of the disclosure. The present invention involves methods and compositions employing mixtures of micronized organic UV filters. This micronization process is disclosed in detail starting on page 23, third paragraph and continuing until page 24, first paragraph and also in the corresponding working examples 1 – 5.

On page 24, second paragraph, the average particle size of the obtained microparticles is disclosed. However, due to a typographical error, the metric units are wrong: “nm” (= nanometers) should read “ $\mu\text{m}$ ” (= micrometers).

One having ordinary skill in the art would certainly that one couldn't micronize an organic particle down to a size of 0.002 nm!

Working examples 1 – 4, wherein the process for preparation of mixtures of the organic microparticles is disclosed in detail, also support the correction. The diameter of the particle size is indicated in these examples:

Example 1: particles size of  $d_{50} = 190 \text{ nm}$  (= 0.190  $\mu\text{m}$ )

Example 2: particles size of  $d_{50} = 200 \text{ nm}$  (= 0.200  $\mu\text{m}$ )

Example 3: particles size of  $d_{50} = 190 \text{ nm}$  (= 0.200  $\mu\text{m}$ )

Example 4: particles size of  $d_{50} = 300 \text{ nm}$  (= 0.300  $\mu\text{m}$ ).

From these examples one of ordinary skill in the art would not only know that page 24, second paragraph was in error, but how to correct it. Hence no new matter has been added.

The claims have been amended in accord with the current rules in which underlining shows additions and strikethrough shows deletions.

Applicants have amended their claims in order to more particularly point out and distinctly claim their invention. Thus, the limits of claim 33 have been incorporated into claim 32. Since claim 33 fails to further limit amended claim 32, it has been presently cancelled. Additionally, claim 32 has been amended to recite an average particle size of from 0.02 to 2  $\mu\text{m}$ . This limits is supported by the

corrected disclosure on page 24, second paragraph and by the exemplification. No new matter has been added.

Claims 32-33 and 34-49 are rejected under 35 U.S.C. § 102(b) as being anticipated by Siegfried, U.S. Patent No. 5,445,815. The examiner asserts that Siegfried discloses each and every aspect of the invention. Applicants respectfully traverse this rejection for the reasons that follow.

Siegfried (U.S. Patent No. 5,445,815) discloses dry sunscreen compositions, including a highly crosslinked polymethacrylate copolymer powder as carrier combined with active sunscreen ingredients.

The dry composition of Siegfried comprises specific and commercially available UV filters like octyl methoxycinnamate, octocrylene, benzophenone-3, and titanium dioxide. There is no disclosure that these UV filters are or can be modified, i.e. they are used as obtained by the corresponding manufacturer.

In fact, in Example 1, in Table 1 a "positive indication of each of the [sunscreen] ingredients" is listed.

Table 1 provides a positive identification of each of the ingredients used in the dry sunscreen formulation of the present invention. The identification includes the Cosmetic, Toiletry and Fragrance Association (CTFA) name and the Chemical Abstracts Number (CAS#).

There is no mention of any modification of these ingredients, i.e. they are used as supplied by the manufacturers.

The only active ingredient which is micronized is Titanium Dioxide (Table 2, Example 2). Titanium dioxide is a well-known inorganic UV filter, which is usually incorporated into cosmetic formulations in the micronized state.

In contrast thereto, the present composition are mixtures of micronized organic UV filters.

The disclosure and teaching of this reference is thus completely different from the presently claimed subject matter. Whereas Siegfried teaches dry sunscreen compositions comprising conventional sunscreens and a specific polymer as carrier, the present invention represents sunscreen compositions comprising mixtures of micronized organic UV filters; i.e. organic UV filters which are

*per se* known from the prior art, but in a new physical form. This new physical form for organic UV filters is neither taught nor suggested by Siegfried.

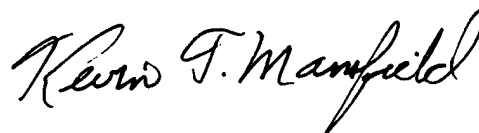
Reconsideration and withdrawal of the rejection of claims 32 and 34-49 under 35 U.S.C. § 102(b) as being anticipated by Siegfried, U.S. Patent No. 5,445,815 is respectfully solicited in light of the remarks *supra*.

Claims 32-58 are rejected under 35 U.S.C. § 102(e) as being anticipated by Fankhauser et al., U.S. Patent No. 6,495,122 B2. Responsive thereto a verified translation of applicant's priority document of **June 18, 1999** is herewith provided. Applicants aver that this document removes Fankhauser et al., effective reference date **July 10, 2000** as prior art. Reconsideration and withdrawal of this ground of rejection is therefore seen to be in order.

Since there are no other grounds of objection or rejection, passage of this application to issue with claims 32 and 34-58 is earnestly solicited.

Applicants submit that the present application is in condition for allowance. In the event that minor amendments will further prosecution, Applicants request that the examiner contact the undersigned representative.

Respectfully submitted,



Ciba Specialty Chemicals Corporation  
540 White Plains Road  
Tarrytown, New York 10591  
(914) 785-7127  
KTM/22037A1

Kevin T. Mansfield  
Agent for Applicants  
Reg. No. 31,635

Enclosures: Verified translation of priority document, Petition for Extension of Time

OCT 30 2003